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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 10/039,837 | 10/18/2001 | Robert J. Greenberg | S100-DIV2 | 1149 |

28284 7590 07/21/2003

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| EXAMINER |
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OROPEZA, FRANCES P

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| ART UNIT | PAPER NUMBER |
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3762

DATE MAILED: 07/21/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/039,837

Applicant(s)

GREENBERG ET AL.

Examiner

Frances P. Oropeza

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10/18/01 (Filing and Prel. Amendment).
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 269-300 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 269-300 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 18 October 2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2. 6) ☐ Other:

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

2. Claims 269-271, 276, 278-280, 285, 287-290, 295 and 297-299 are rejected under 35 U.S.C. 102(e) as being anticipated by Eckmiller (US 6400989). Edkmiller discloses a visual prosthetic comprising an encoder (read as including the video receiver, video procession unit, and external communications unit), an implanted carrier (read as the internal communication unit) and implanted micro-contacts located in the retina (read as the plurality of electrodes) (figure 2; col. 3 @ 49-59; col. 3 @ 66 – col. 4 @ 10; col. 8 @ 54-61;).

As to claims 270, 271, 279, 280, 289 and 290, the operational data includes electrode current (col. 5 @ 60-64).

As to claims 276, 285, 295 and 299, electrical recordings from the retina are communicated (col. 3 @ 49-50; col. 4 @ 18-26; col. 7 @ 23-32; col. 11 @ 23-35).

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint Inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the Examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. The Applicant is advised of the obligation under 37 CFR 1.56 to point out the Inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

4. Claims 272-275, 277, 281-284, 286, 291-294, 296 and 300 are rejected under 35 U.S.C. 103(a) as being unpatentable over Eckmiller (US 6400989) in view of Michelson (US 4628933). As discussed in paragraph 2 of this action, Eckmiller discloses the claimed invention except for the operational data including:

- electrode impedance (claims 272, 281 and 291),
- electrode voltage (claims 273, 274, 282, 283, 292 and 293),
- an indication that a compliance voltage has been reached (claims 275, 284 and 294), and
- an indication of power level (claims 277, 286, 296 and 300).

Michelson teaches the composition of an ideal visual neuron stimulating signal comprises electrode impedance, electrode voltage, an indication that a compliance voltage has been reached (read as threshold), and an indication of power level, these elements included for the purpose of taking into account the physiological and/ or operating factors (impedance, voltage and power) to provide comprehensive feedback

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that enables creation of an optimum visual stimulation signal. It would have been obvious to one having ordinary skill in the art at the time of the invention to have used electrode impedance, electrode voltage, an indication that a compliance voltage has been reached, and an indication of power level in the Eckmiller system in order to provide effective bi-directional communication signals that enable induction of visual perception in individuals where the optical pathway of the eye and the neural response of the retina are intact (col. 2 @ 21-24; col. 3 @ 65 – col. 4 @ 17; col. 4 @ 18-33; col. 4 @ 52-65; col. 5 @ 31-34).

Drawings

5. Figures 4 and 5 are objected to under 37 CFR 1.83(a) because the rectangular boxes are not labeled as described in the specification. Any structural detail that is essential for a proper understanding of the disclosed invention should be shown in the drawing. MPEP § 608.02(d). A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

Declaration

6. The oath or declaration is defective. A new oath or declaration in compliance with 37 CFR 1.67(a) identifying this application by application number and filing date is required. See MPEP §§ 602.01 and 602.02.

The oath or declaration is defective because the Robert J. Greenberg signature is not dated.

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Information Disclosure Statement

7. One of the references, WO 81/01512, of the information disclosure statement filed 2/7/02 fails to comply with 37 CFR 1.98(a)(3) because it does not include a concise explanation of the relevance, as it is presently understood by the individual designated in 37 CFR 1.56(c) most knowledgeable about the content of the information, of each patent listed that is not in the English language. The information disclosure statement, with the noted reference marked through, has been placed in the application file, but the information referred to therein has not been considered. The submitted abstract does not meet the "concise explanation of the relevance".

Conclusion

Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Fran Oropeza, telephone number is (703) 605-4355. The Examiner can normally be reached on Monday – Thursday from 6 a.m. to 4:30 p.m.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's Supervisor, Angela D. Sykes can be reached on (703) 308-5181. The fax phone number for the organization where this application or proceeding is assigned is (703) 306-4520 for regular communication and for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Receptionist, telephone number is (703) 308-0858.

Frances P. Oropeza
Patent Examiner
Art Unit 3762

FPO
7/10/03

Angela D. Sykes

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